

109TH CONGRESS  
1ST SESSION

# H. R. 683

To amend the Trademark Act of 1946 with respect to dilution by blurring  
or tarnishment.

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## IN THE HOUSE OF REPRESENTATIVES

FEBRUARY 9, 2005

Mr. SMITH of Texas introduced the following bill; which was referred to the  
Committee on the Judiciary

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## A BILL

To amend the Trademark Act of 1946 with respect to  
dilution by blurring or tarnishment.

1       *Be it enacted by the Senate and House of Representa-*  
2       *tives of the United States of America in Congress assembled,*

3       **SECTION 1. SHORT TITLE.**

4       (a) **SHORT TITLE.**—This Act may be cited as the  
5       “Trademark Dilution Revision Act of 2005”.

6       (b) **REFERENCES.**—Any reference in this Act to the  
7       Trademark Act of 1946 shall be a reference to the Act  
8       entitled “An Act to provide for the registration and protec-  
9       tion of trademarks used in commerce, to carry out the pro-  
10      visions of certain international conventions, and for other

1 purposes”, approved July 5, 1946 (15 U.S.C. 1051 et  
2 seq.).

3 **SEC. 2. DILUTION BY BLURRING; DILUTION BY**  
4 **TARNISHMENT.**

5 Section 43 of the Trademark Act of 1946 (15 U.S.C.  
6 1125) is amended—

7 (1) by striking subsection (c) and inserting the  
8 following:

9 “(c) DILUTION BY BLURRING; DILUTION BY  
10 TARNISHMENT.—

11 “(1) INJUNCTIVE RELIEF.—Subject to the prin-  
12 ciples of equity, the owner of a famous mark that is  
13 distinctive, inherently or through acquired distinc-  
14 tiveness, shall be entitled to an injunction against  
15 another person who, at any time after the owner’s  
16 mark has become famous, commences use of a mark  
17 or trade name in commerce as a designation of  
18 source of the person’s goods or services that is likely  
19 to cause dilution by blurring or dilution by  
20 tarnishment, regardless of the presence or absence  
21 of actual or likely confusion, of competition, or of ac-  
22 tual economic injury.

23 “(2) DEFINITIONS.—(A) For purposes of para-  
24 graph (1), a mark is famous if it is widely recog-  
25 nized by the general consuming public of the United

1 States as a designation of source of the goods or  
2 services of the mark's owner. In determining wheth-  
3 er a mark possesses the requisite degree of recogni-  
4 tion, the court may consider all relevant factors, in-  
5 cluding the following:

6 “(i) The duration, extent, and geographic  
7 reach of advertising and publicity of the mark,  
8 whether advertised or publicized by the owner  
9 or third parties.

10 “(ii) The amount, volume, and geographic  
11 extent of sales of goods or services offered  
12 under the mark.

13 “(iii) The extent of actual recognition of  
14 the mark.

15 “(B) For purposes of paragraph (1), ‘dilution  
16 by blurring’ is association arising from the similarity  
17 between a designation of source and a famous mark  
18 that impairs the distinctiveness of the famous mark.  
19 In determining whether a designation of source is  
20 likely to cause dilution by blurring, the court may  
21 consider all relevant factors, including the following:

22 “(i) The degree of similarity between the  
23 designation of source and the famous mark.

24 “(ii) The degree of inherent or acquired  
25 distinctiveness of the famous mark.

1           “(iii) The extent to which the owner of the  
2 famous mark is engaging in substantially exclu-  
3 sive use of the mark.

4           “(iv) The degree of recognition of the fa-  
5 mous mark.

6           “(v) Whether the user of the designation of  
7 source intended to create an association with  
8 the famous mark.

9           “(vi) Any actual association between the  
10 designation of source and the famous mark.

11          “(C) For purposes of paragraph (1), ‘dilution  
12 by tarnishment’ is association arising from the simi-  
13 larity between a designation of source and a famous  
14 mark that harms the reputation of the famous mark.

15          “(3) EXCLUSIONS.—The following shall not be  
16 actionable as dilution by blurring or dilution by  
17 tarnishment under this subsection:

18               “(A) Fair use of a famous mark by an-  
19 other person in comparative commercial adver-  
20 tising or promotion to identify the competing  
21 goods or services of the owner of the famous  
22 mark.

23               “(B) Noncommercial use of a designation  
24 of source.

1           “(C) All forms of news reporting and news  
2           commentary.

3           “(4) ADDITIONAL REMEDIES.—In an action  
4           brought under this subsection, the owner of the fa-  
5           mous mark shall be entitled only to injunctive relief  
6           as set forth in section 34, except that, if—

7           “(A) the person against whom the injunc-  
8           tion is sought did not use a mark or trade  
9           name that is likely to cause dilution by blurring  
10          or dilution by tarnishment as a designation of  
11          source in commerce prior to the date of the en-  
12          actment of the Trademark Dilution Revision  
13          Act of 2005, and

14          “(B) in a claim arising under this sub-  
15          section—

16               “(i) by reason of dilution by blurring,  
17               the person against whom the injunction is  
18               sought willfully intended to trade on the  
19               recognition of the famous mark, or

20               “(ii) by reason of dilution by  
21               tarnishment, the person against whom the  
22               injunction is sought willfully intended to  
23               trade on the reputation of the famous  
24               mark,

1 the owner of the famous mark shall also be entitled  
 2 to the remedies set forth in sections 35(a) and 36,  
 3 subject to the discretion of the court and the prin-  
 4 ciples of equity.

5 “(5) OWNERSHIP OF VALID REGISTRATION A  
 6 COMPLETE BAR TO ACTION.—The ownership by a  
 7 person of a valid registration under the Act of  
 8 March 3, 1881, or the Act of February 20, 1905, or  
 9 on the principal register under this Act shall be a  
 10 complete bar to an action against that person, with  
 11 respect to that mark, that is brought by another  
 12 person under the common law or a statute of a  
 13 State and that seeks to prevent dilution by blurring  
 14 or dilution by tarnishment, or that asserts any claim  
 15 of actual or likely damage or harm to the distinctive-  
 16 ness or reputation of a mark, label, or form of ad-  
 17 vertisement.”; and

18 (2) in subsection (d)(1)(B)(i)(IX), by striking  
 19 “(c)(1) of section 43” and inserting “(c)”.

### 20 **SEC. 3. CONFORMING AMENDMENTS.**

21 (a) MARKS REGISTRABLE ON THE PRINCIPAL REG-  
 22 ISTER.—Section 2(f) of the Trademark Act of 1946 (15  
 23 U.S.C. 1052(f)) is amended—

24 (1) by striking the last two sentences; and

1           (2) adding at the end the following: “A mark  
2       which, when used as a designation of source for the  
3       applicant’s goods or services, would be likely to  
4       cause dilution by blurring or dilution by tarnishment  
5       under section 43(c), may be refused registration only  
6       pursuant to a proceeding brought under section 13.  
7       A registration for a mark which, when used as a  
8       designation of source for the registrant’s goods or  
9       services, would be likely to cause dilution by blurring  
10      or dilution by tarnishment under section 43(c), may  
11      be canceled pursuant to a proceeding brought under  
12      either section 14 or section 24.”

13      (b) OPPOSITION.—Section 13(a) of the Trademark  
14      Act of 1946 (15 U.S.C. 1063(a)) is amended in the first  
15      sentence by striking “as a result of dilution” and inserting  
16      “the registration of any mark which, when used as a des-  
17      ignation of source for the applicant’s goods or services,  
18      would be likely to cause dilution by blurring or  
19      tarnishment”.

20      (c) CANCELLATION.—Section 14 of the Trademark  
21      Act of 1946 (15 U.S.C. 1064) is amended, in the matter  
22      preceding paragraph (1)—

23           (1) by striking “, including as a result of dilu-  
24      tion under section 43(c),”; and

1           (2) inserting “(A) for which the constructive  
2           use date is after the date on which the petitioner’s  
3           mark became famous and which, when used as a  
4           designation of source for the registrant’s goods or  
5           services, would be likely to cause dilution by blurring  
6           or dilution by tarnishment under section 43(c), or  
7           (B) on grounds other than dilution by blurring or di-  
8           lution by tarnishment” after “February 20, 1905”.

9           (d) MARKS FOR THE SUPPLEMENTAL REGISTER.—  
10          The second sentence of section 24 of the Trademark Act  
11          of 1946 (15 U.S.C. 1092) is amended to read as follows:  
12          “Whenever any person believes that such person is or will  
13          be damaged by the registration of a mark on the supple-  
14          mental register—

15                 “(1) for which the effective filing date is after  
16                 the date on which such person’s mark became fa-  
17                 mous and which, when used as a designation of  
18                 source for the registrant’s goods or services, would  
19                 be likely to cause dilution by blurring or dilution by  
20                 tarnishment under section 43(c), or

21                 “(2) on grounds other than dilution by blurring  
22                 or dilution by tarnishment,  
23          such person may at any time, upon payment of the pre-  
24          scribed fee and the filing of a petition stating the ground



1 therefor, apply to the Director to cancel such registra-  
2 tion.”.

3 (e) DEFINITIONS.—Section 45 of the Trademark Act  
4 of 1946 (15 U.S.C. 1127) is amended by striking the defi-  
5 nition relating to “dilution”.

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